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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,793	12/03/2003	John Carney	40004572-0022-002	6787
26263                      7590                      10/14/2009 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, WILLIS TOWER CHICAGO, IL 60606-1080				
EXAMINER SCHNURR, JOHN R				
ART UNIT 2421		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/727,793

**Applicant(s)**

CARNEY ET AL.

**Examiner**

JOHN SCHNURR

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to the Pre-Brief Appeal Conference Decision, dated 07/29/2009, to reopen prosecution. Claims 1-47 are pending and have been examined.

#### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-13, 15-19, 22-29, 31-35, 38-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Begeja et al. (US 2003/0030752)**, herein Begeja, in view of **Logan et al. (US 2003/0093790)**, herein Logan, further in view of **Dougherty et al. (US 7,028,327)**, herein Dougherty.

Consider **claim 1**, Begeja clearly teaches a method comprising:

providing one or more lists, each list containing a plurality of video-on-demand (VOD) clips; **(A list of topics each containing a list of clips is presented to the user, [0051], the clips may be video-on-demand content, [0058].)**

receiving user input, the user input specifying a set of two or more of the plurality of VOD clips and their sequencing order; **(The user selects clips to be played, [0063]-[0064]. The clips may be played in a predetermined order, [0065].)**

creating a composite VOD clip sequence wherein each of the specified set of VOD clips is a component VOD clip of the composite VOD clip sequence; **(The clips may be stitched together and streamed to the user, [0055].)**

However, Begeja does not explicitly teach the user input specifying a user defined sequencing order.

In an analogous art, Logan, which discloses a system for creating a VOD clip sequence, clearly teaches user input specifying a user defined sequencing order. **([0360]-[0366])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja by specifying a user defined sequencing order, as taught by Logan, for the benefit of presenting only segments of interest to a viewer.

However, Begeja combined with Logan does not explicitly teach automatically inserting one or more iTV application elements within the composite VOD clip according to characteristics of the component VOD clips comprising the composite VOD clip.

In an analogous art, Dougherty, which discloses a system for video distribution, clearly teaches automatically inserting one or more iTV application elements within a video stream according to characteristics of the video. **(col. 11 line 60 to col. 12 line 11)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja combined with Logan by automatically inserting one or more iTV application elements within a video stream according to characteristics of the video, as taught by Dougherty, for the benefit of maintaining synchronicity of the video and interactive application.

Consider **claim 2**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches presenting the composite VOD clip sequence to the user to effect a passive viewing experience. **(A show will play all the way through if not interrupted by the user, [0053] Begeja.)**

Consider **claim 3**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches creation of the composite VOD clip is based upon the specified sequencing order. **(The clips may be played in a predetermined order, [0065] Begeja.)**

Consider **claim 6**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches storing the composite VOD to a storage medium. **(Fig. 5: Button 580 allows the user to archive the clips, [0065] Begeja.)**

Consider **claim 7**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches the storage medium is included in a digital video recorder. **([0032] Begeja)**

Consider **claim 8**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches presenting the composite VOD clip sequence includes recognizing the completion of a component VOD clip and automatically commencing presentation of a subsequent component VOD clip. **(The clips are stitched together and streamed as one continuous program, [0055] Begeja.)**

Consider **claim 9**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches presenting the composite VOD clip sequence includes initiating a new session for a component VOD clip prior to completion of presentation of a previous component VOD clip. **(While previously obtained and locally stored information is being played a second media stream is being delivered and/or buffered for viewing, [0086] Begeja.)**

Consider **claim 10**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches creating the composite VOD clip sequence includes creating a VOD file such that each component VOD clip is a segment of the VOD file. **([0055] Begeja)**

Consider **claim 11**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches transition between component VOD clips is accomplished by moving to specific time codes within the VOD file. **(The player identifies the clip based on the start time timestamp, [0046] and [0053] Begeja.)**

Consider **claim 12**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches creating the composite VOD clip sequence includes concatenating each of the VOD clips of the selected set of two or more VOD clips. **([0055] Begeja)**

Consider **claim 13**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches including component VOD clip metadata in or with the composite VOD clip. **(Information associated with the clip may be displayed, [0064] Begeja.)**

Consider **claim 15**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches inserting additional component VOD clips in the composite VOD

clip sequence. **(Advertisements may be inserted into the video stream, [0057] Begeja.)**

Consider **claim 16**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches the additional component VOD clips are automatically inserted in the composite VOD clip sequence based upon a set of predefined rules. **(The commercials are inserted between every third clip, [0057] Begeja.)**

Consider **claim 17**, Begeja clearly teaches a machine-readable medium having stored thereon executable instructions which when executed by a processor cause a method to be performed, the method comprising:

providing a list containing a plurality of VOD clips; **(A list of topics each containing a list of clips is presented to the user, [0051], the clips may be video-on-demand content, [0058].)**

receiving user input, the user input specifying a set of two or more of the plurality of video-on-demand clips and their sequencing order; **(The user selects clips to be played, [0063]-[0064]. The clips may be played in a predetermined order, [0065].)**

creating a composite VOD clip sequence wherein each of the specified set of VOD clips is a component VOD clip of the composite VOD clip sequence; **(The clips may be stitched together and streamed to the user, [0055].)**

However, Begeja does not explicitly teach the user input specifying a user defined sequencing order.

In an analogous art, Logan, which discloses a system for creating a VOD clip sequence, clearly teaches user input specifying a user defined sequencing order. **([0360]-[0366])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja by specifying a user defined sequencing order, as taught by Logan, for the benefit of presenting only segments of interest to a viewer.

However, Begeja combined with Logan does not explicitly teach automatically inserting one or more iTV application elements within the composite VOD clip according to characteristics of the component VOD clips comprising the composite VOD clip.

In an analogous art, Dougherty, which discloses a system for video distribution, clearly teaches automatically inserting one or more iTV application elements within a video stream according to characteristics of the video. **(col. 11 line 60 to col. 12 line 11)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja combined with Logan by automatically inserting one or more iTV application elements within a video stream according to characteristics of the video, as taught by Dougherty, for the benefit of maintaining synchronicity of the video and interactive application.

Consider **claim 18**, see claim 2.  
Consider **claim 19**, see claim 3.  
Consider **claim 22**, see claim 6.  
Consider **claim 23**, see claim 7.  
Consider **claim 24**, see claim 8.  
Consider **claim 25**, see claim 9.  
Consider **claim 26**, see claim 10.  
Consider **claim 27**, see claim 11.  
Consider **claim 28**, see claim 12.  
Consider **claim 29**, see claim 13.  
Consider **claim 31**, see claim 15.  
Consider **claim 32**, see claim 16.

Consider **claim 33**, Begeja clearly teaches a system comprising:

a server storing VOD content, the VOD content including a plurality of VOD clips; **(Fig. 2: Video server 220 retrieves the clips from storage 210, [0043] and [0045].)**

a set top box coupled to the server, **(Fig. 2 eClips client 250, [0054])** the set top box storing an application, **([0049])** the application including a VOD clip selection functionality, that enables a user to access the plurality of VOD clips and select a set of two or more VOD clips of the plurality of VOD clips, **(The user selects clips to be played, [0063]-[0064].)** a VOD clip sequence ordering functionality that allows a user to specify a sequencing order for the set of selected VOD clips, **(The clips may be played in a predetermined order, [0065].)** and a VOD clip composite functionality that creates a composite VOD clip sequence wherein each of the two or more VOD clips of the selected set of VOD clips is a component VOD clip of the composite VOD clip sequence; **(The clips may be stitched together and streamed to the user, [0055].)**

However, Begeja does not explicitly teach the user input specifying a user defined sequencing order.

In an analogous art, Logan, which discloses a system for creating a VOD clip sequence, clearly teaches user input specifying a user defined sequencing order. **([0360]-[0366])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja by specifying a user defined sequencing order, as taught by Logan, for the benefit of presenting only segments of interest to a viewer.

However, Begeja combined with Logan does not explicitly teach automatically inserting one or more iTV application elements within the composite VOD clip according to characteristics of the component VOD clips comprising the composite VOD clip.

In an analogous art, Dougherty, which discloses a system for video distribution, clearly teaches automatically inserting one or more iTV application elements within a video stream according to characteristics of the video. **(col. 11 line 60 to col. 12 line 11)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja combined with Logan by automatically inserting one or more iTV application elements within a video stream according to characteristics of the video, as taught by Dougherty, for the benefit of maintaining synchronicity of the video and interactive application.

Consider **claim 34**, see claim 2.  
Consider **claim 35**, see claim 3.  
Consider **claim 38**, see claim 6.  
Consider **claim 39**, see claim 7.  
Consider **claim 40**, see claim 8.  
Consider **claim 41**, see claim 9.  
Consider **claim 42**, see claim 10.  
Consider **claim 43**, see claim 11.  
Consider **claim 44**, see claim 12.  
Consider **claim 45**, see claim 13.  
Consider **claim 47**, see claim 16.

5. Claims **4, 5, 20, 21, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Begeja et al. (US 2003/0030752)** in view of **Logan et al. (US**



**2003/0093790**) in view of **Dougherty et al. (US 7,028,327)** further in view of

**Shimomura et al. (US 6,526,580)**, herein Shimomura.

Consider **claim 4**, Begeja combined with Logan and Dougherty, as in claim 1, clearly teaches selecting the segments to be played in a specific order. **(The clips may be played in a predetermined order, [0065] Begeja.)**

However, Begeja combined with Logan does not explicitly teach traversing a decision tree having a plurality of decision nodes.

In an analogous art Shimomura, which discloses a system for providing program segments on demand, clearly teaches selecting video clips by traversing a decision tree having a plurality of decision nodes. **(Fig. 9 column 12 line 58 to column 13 line 10)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja combined with Logan and Dougherty by selecting video clips by traversing a decision tree having a plurality of decision nodes, as taught by Shimomura, for the benefit of easily locating segments of interest.

Consider **claim 5**, Begeja combined with Logan, Dougherty and Shimomura, as in claim 4, clearly teaches the decision tree is structured such that specifying a VOD clip at each node constrains selection of VOD clips at subsequent nodes. **(Fig. 9 Shimomura)**

Consider **claim 20**, see claim 4.

Consider **claim 21**, see claim 5.

Consider **claim 36**, see claim 4.

Consider **claim 37**, see claim 5.

6. Claims **14, 30 and 46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Begeja et al. (US 2003/0030752)** in view of **Logan et al. (US 2003/0093790)** in view of **Dougherty et al. (US 7,028,327)** further in view of **Mitchell (US 2002/0162120)**.

Consider **claim 14**, Begeja combined with Logan, as in claim 1, clearly teaches including VOD component metadata. **(Information associated with the clip may be displayed, [0064] Begeja.)**

However, Begeja combined with Logan and Dougherty does not explicitly teach the metadata is a uniform resource locator.

In an analogous art Mitchell, which discloses a system for transferring video information, clearly teaches transmitting metadata using URLs. **([0064])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Begeja combined with Logan and Dougherty by transmitting the metadata using URLs, as taught by Mitchell, for the benefit of enabling the STB to access the Internet ([0003] Mitchell).

Consider **claim 30**, see claim 14.  
Consider **claim 46**, see claim 14.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on M-F 9a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

JRS